



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/096,663	06/12/98	KRUPKE	L B-60857

PM32/0604

KENNETH P GLASER  
AKIN GUMP STRAUSS HAUER & FELD  
1700 PACIFIC AVENUE SUITE 4100  
DALLAS TX 75201-4618

EXAMINER

COHEN, C

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 06/04/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/096,663**

Applicant(s)  
**Krupke et al**

Examiner  
**Curtis Cohen**

Group Art Unit  
**3634**



☒ Responsive to communication(s) filed on Jun 12, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-35 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jun 12, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3634

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the line 5-5 in Figure 2 as indicated in the brief description of the drawings. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants have positively set for the subcombination of a counterbalance system in the preambles of the independent claims while functionally reciting a door. This is not a problem as long as the body of the claims and the depending claims functionally recite a door. In claim 1, line 6 and line 9, claim 25, line 6 and 13, and claim 31, lines 4 and 8, applicants make a positive recitation to the door which leads one to believe that it is applicants' intent to positively recite the combination of the door and the counterbalance. That is, given the positive association of the drums with the door, it is not clear whether the door is a requirement of the claim. To be

Art Unit: 3634

consistent with the preamble, the recitations to the door in lines 6 and 9 must be function.

Language such as "for use with" or "adapted to" are common functional phrases that might help in rewording the recitation of the door.

Regarding claim 12, the word "means" is preceded by the word(s) "bearing" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim 12, line 6, it is not clear how the bearing retainer is engagable with the both of the brackets at once. It appears as if the retainer is engagable with **each** of said brackets respectively.

Regarding claim 22, the word "means" is preceded by the word(s) "key" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Regarding claim 22, the word "means" is preceded by the word(s) "keyway" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Art Unit: 3634

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Carper et al #5,636,678. Carper et al teach a counterbalance system including rotatable drums mounted on a shaft through a bearing system. The drums are mounted to a bearing plate 96 having bearing 48. The inner race 98 mounts the bears, the bearing plate and the drum to the shaft. The counterbalance system also includes a torsion spring mounted around the shaft to further counter balance the weight of the door. An elongated tube 252 is disposed in sleeved relationship over the spring and is operably connected to the spring (see column 7, lines 37 through column 8, line 8). The winding mechanism is a worm 70 and spur gear 56. As best shown in Figure 9 and described in column 12, a winding mechanism 226 is connected to the telescoping tube 252. It should be noted that the embodiment of Figures 1-4 and the Figures 8-10 are identical with the exception of the telescoping tube 252. Therefore, the teachings of the two embodiments may properly be discussed as one teaching. A counter 266 and indicia 268 are provided to indicate the number of windings of the spring. The counter includes a pin 269. Spaced apart brackets are taught by 40 and 42. A second support plate 74 has arcuate recesses to accept the worm gear. With respect to claim 12, the bearing is taught by 48, the brackets are taught by 234 and the

Art Unit: 3634

inclined slot is taught by 273. Claim 16, the spring is mounted to a hub assembly 60, the key plate is the tube 238 and the cooperating means is taught by the 284 which engages the keyway 282.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carper et al '544 are cited for teaching a worm and spur gear spring tensioning mechanism. Blodgett is cited for teaching the tube 53. Bin is cited for teaching the brackets 22 and 23. Robinson is cited for teaching the bracket 52. Stroup et al are cited for teaching the entire winding mechanism. Row is cited for teaching Figure 5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen

June 1, 1999



Daniel P. Stodola  
Supervisory Patent Examiner  
Group 3600